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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,607	05/31/2001	Timur Yarovinsky	UIA-031.01	1145
7590 01/14/2004				
Steven L. Highlander FULBRIGHT 7 JAWORSKI 600 Congress Avenue, Suite 2400 Austin, TX 78701		EXAMINER MYERS, CARLA J		
		ART UNIT PAPER NUMBER 1634		

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/871,607

Applicant(s)

YAROVINSKY, TIMUR

Examiner

Carla Myers

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 29 December 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,2,4-10,21 and 22.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☒ The drawing correction filed on 29 December 2003 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

*Carla Myers*  
CARLA J. MYERS  
PRIMARY EXAMINER

Continuation of 2. NOTE: the amendment to the claim 1 raises new issues under 35 U.S.C. 102/103 since the amendment modifies the scope of the claim by deleting the species of "intronic sequences" from the recited Markush group.

Continuation of 5. does NOT place the application in condition for allowance because: for the reasons of record in view of the non-entry of the after final amendment. Further, Applicants have not defined in their specification and have not provided any showing that the art requires that a polypeptide tag sequence or a fusable protein encoding sequence be of any particular amino acid length. Two codons do in fact encode for a peptide of 2 amino acids and such a sequence can serve the generic functions of encoding a protein or a polypeptide tag. With respect to the 102 rejection over Hudson, Applicants state that the examiner's previous response "does not make any sense." Applicants state that the first and second nucleic acids are distinct molecules. However, the claims do not recite that the first and second molecules are distinct from one another. Claim 4 does not in fact require a second nucleic acid. Thereby, applicants are arguing limitations not recited in the claim. In claim 5, the second nucleic acid comprises a 5' sequence that is "complementary" with the 5' strand of the scissile strand. Applicants refer to page 4 of the specification as teaching that complementary molecules are a pair of single stranded nucleic acids that anneal. However, this is not an accurate description of the teachings at page 4. Rather, page 4 states that the term complementary describes the capacity of a pair of single stranded terminal sequences to anneal to one another via base pairing. The specification does not state that because a pair of single stranded molecules have the capacity to anneal, that the specification is thereby defining all complementary nucleic acids to include only a pair of 2 separate, single stranded nucleic acid. The teachings at page 4 of the specification does not limit the properties of the adaptor to include 2 separate nucleic acid molecules. There are no limitations in claim 5 which would suggest that the claim is intended to be limited to 2 separate nucleic acid molecules that are annealed to one another. And the teachings in the specification regarding the annealing of terminal single stranded nucleic acids does not result in the claims being limited to adaptors which comprise 2 separate, annealed single-stranded nucleic acids. Again, Hudson does in fact teach the limitations recited in claim 5 of an adaptor comprising a first and second nucleic acid since the sequence of Hudson includes "AGGA" which is complementary to the "TCCT" topoisomerase cleavage site.